



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/270,461	03/15/1999	JONATHAN D. BUCKLEY		2532

7590 04/23/2004
FINNEGAN HENDERSON FARABOW GARRETT & DUNNER LLP
1300 I Street NW
Washington, DC 20005-3315

EXAMINER

SHIMIZU, MATSUICHIRO

ART UNIT	PAPER NUMBER
----------	--------------

2635

DATE MAILED: 04/23/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/270,461

Applicant(s)

BUCKLEY ET AL.

Examiner

Matsuichiro Shimizu

Art Unit

2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Amendment

The examiner acknowledges canceled claims 15-24 and new claims 25-29.

Response to Arguments

Applicant's arguments with respect to claims 25-29 are moot as evidenced by new grounds of rejection.

Claims 25-29 of this application has been copied by the applicant from U. S. Patent No.6,293,039. This claim is not patentable to the applicant because of:

Three grounds of rejection presented below;

- (1) Claim Rejections – 35 USC § 112
- (2) Claim Rejections – 35 USC § 135(b)
- (3) Claim Rejections – 35 USC § 102.

Interference cannot be initiated since a prerequisite for interference under 37 CFR 1.606 is that the claim be patentable to the applicant subject to a judgment in the interference.

1). ***Claim Rejections – 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 25–29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

“the control unit configured to compare the signal inputted into the identification unit with stored identification code” as claimed in claim 25 is new subject matter which was not described in the specification as originally filed. The specification page 15, line 15–page 16, line 11 merely suggests entering a correct code using a keypad allows for firearm to be in a position to work normally. There is no indication of comparing inputted signal into id unit with stored id code.

Claims 26–29 are directly/ or indirectly dependent on claim 25, therefore, failing to comply with the written description requirement fairly suggest claims 26–29 for same reason that failing to comply with the written description requirement fairly suggests claim 25.

2).

Claim Rejections – 35 USC § 135(b)

Claims 25–29 are rejected under 35 U.S.C. 135(b) as not being made prior to one year from the date on which U.S. Patent No. 6,293,039 was granted. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632,1635 (Fed. Cir. 1997) where the Court held that the application of 35 U.S.C. 135(b) is not limited to inter partes interference proceedings, but may be used as a basis for ex parte rejections.

Claims 1–5 (US 6,293,039) are not the same as claims 1–14 originally filed in application (appl.–09/270461) as shown below:

“A pistol” in claim 1 (US 6,293,039) is narrower and thus not the same as “a firearm” in claim 1 (appl.–09/270461).

“id signal inputted into identification unit” in claim 1 (US 6,293,039) is broader than “selection buttons for enabling selection of a series of numbers in sequence” in claim 3 (appl.–09/270461), and therefore, is not the same..

“control unit configured to compare the signal inputted into the identification unit with a stored identification code” in claim 1 (US 6,293,039) is not the same as “microprocessor responsive to correct selection of said selection buttons” in claim 3 (appl.–09/270461). Note no indication in patent claims that a microprocessor is used. Also, no indication in an application claims that a comparison of an inputted signals is made with a stored id code.

“a threaded spindle and nut connection” in claim 1 (US 6,293,039) is not the same as “threaded output shaft” in claim 7 (appl.–09/270461) and “threaded box” in claim 8 (appl.–09/270461), because, claim 8 is not dependent on claim 7. Therefore, there is no indication in the claims that the threaded shaft and box were intended to be claimed together as the patent claims require.

“a battery” in claim 1 (US 6,293,039) is broader than “an expendable battery” in claim 14 (appl.–09/270461).

“notch” in claim 2 (US 6,293,039) is not the same as an “aperture” in claim 5 (appl.–09/270461). Notch refers to a cut in to an object and an aperture is a hole.

"spring loaded" in claim 2 (US 6,293,039) is narrower and thus not the same as "resilient means" in claim 8 (appl.-09/270461).

"a plurality of display elements" in claim 1 (US 6,293,039) is not claimed in appl.-09/270461.

All of the limitations of Claims 3 and 5 (US 6,293,039) are not claimed in appl.-09/270461.

"keypad for the input of code" in claim 4 (US 6,293,039) is broader than "keypad to select buttons for enabling selection of numbers in sequence" in claim 3 (appl.-09/270461) and therefore is not the same.

3). *Claim Rejections – 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 25–29 are rejected under 35 U.S.C. 102(e) as being anticipated by Fuchs (6,293,039).

Regarding claim 25, Fuchs teaches a pistol having a locking mechanism configured to lock a trigger mechanism of the pistol if an attempt is made by an unauthorized person to fire the pistol, the locking mechanism comprising: an identification unit configured to detect an identification signal imputed into the identification unit; a control unit connected to the identification unit, the control unit configured to compare the signal inputted into the identification unit with a stored identification code; an actuator device including a geared motor connected to the control unit and connected by a threaded spindle and nut connection with a mechanical locking element which is movable between a locked position an unlocked position, wherein in the locked position the locking element locks a trigger tongue of the pistol; a battery for supplying electrical power to the locking mechanism; and a plurality of display elements configured to display an operating status of the locking mechanism (claim 1).

Regarding claim 26, Fuchs teaches a pistol as claimed in claim 25, wherein the locking element is configured to engage a notch in the trigger tongue, and wherein the locking element is guided for movement in a bolt and is spring-loaded (claim 2).

Regarding claim 27, Fuchs teaches a pistol as claimed in claim 25, wherein at least the greater portion of the locking mechanism is located in front of a trigger guard and below the barrel of the pistol (claim 3).

Regarding claim 28, Fuchs teaches a pistol as claimed in claim 25, wherein the identification unit comprises a keypad for the input of the code (claim 4).

Regarding claim 29, Fuchs teaches a pistol as claimed in claim 25, wherein the identification unit comprises a fingerprint scanner (claim 5).

Art Unit: 2635

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matsuichiro Shimizu whose telephone number is (703) 306-5841. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik, can be reached on (703-305-4704). The fax phone number for the organization where this application or proceeding is assigned is (703-305-3988).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703-305-8576).

Matsuichiro Shimizu

April 18, 2004



**MICHAEL HORABIK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600**

